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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

10/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/729,454

Applicant(s)

LASEK ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to isolated cDNA, an antigenic epitope, a probe, a vector, and a host cell, classified in class 536, subclass 23.1.
 - II. Claim 9, drawn to a method of producing a protein, classified in class 435, subclass 70.1.
 - III. Claim 10, drawn to a transgenic cell line, classified in class 435, subclass 325.
 - IV. Claims 11-13, drawn to a method of detecting differential nucleic acid expression in a sample using cDNA, classified in class 435, subclass 6.
 - V. Claim 14-16, drawn to a method of screening using cDNA, classified in class 435, subclass 4.
 - VI. Claims 16-17, drawn to a protein and a composition, classified in class 530, subclass 350.
 - VII. Claims 18-19, drawn to a method of screening using a protein, classified in class 435, subclass 7.1.
 - VIII. Claim 20, drawn to a method of preparing and purifying an antibody, classified in class 530, subclass 387.1.
2. In the event applicant elects Group I, claims 1-8, applicant is required to elect a single species of cDNA. Claims 1-3 are generic to a plurality of disclosed patentably distinct species comprising:
 - Species A, drawn to SEQ ID NO: 1
 - Species B, drawn to SEQ ID NO: 2
 - Species C, drawn to SEQ ID NO: 3
 - Species D, drawn to SEQ ID NO: 4
 - Species E, drawn to SEQ ID NO: 5
 - Species F, drawn to SEQ ID NO: 6

Species G, drawn to SEQ ID NO: 7
Species H, drawn to SEQ ID NO: 8
Species I, drawn to SEQ ID NO: 9
Species J, drawn to SEQ ID NO: 10
Species K, drawn to SEQ ID NO: 11
Species L, drawn to SEQ ID NO: 12
Species M, drawn to SEQ ID NO: 13
Species N, drawn to SEQ ID NO: 14
Species O, drawn to SEQ ID NO: 15
Species P, drawn to SEQ ID NO: 16
Species Q, drawn to SEQ ID NO: 17
Species R, drawn to SEQ ID NO: 18
Species S, drawn to SEQ ID NO: 19
Species T, drawn to SEQ ID NO: 20
Species U, drawn to SEQ ID NO: 21
Species V, drawn to SEQ ID NO: 22
Species W, drawn to SEQ ID NO: 23
Species X, drawn to SEQ ID NO: 24
Species Y, drawn to SEQ ID NO: 25
Species Z, drawn to SEQ ID NO: 26
Species 1, drawn to SEQ ID NO: 27
Species 2, drawn to SEQ ID NO: 28
Species 3, drawn to SEQ ID NO: 29

Species A-3 are patentably distinct based on structural and functional differences and mode of action, as species may target different receptors.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I, III, VI (products) and II, IV-V, VII-VIII (methods) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following

can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of Groups I, VI may be used for a number of different processes that are very much unrelated. For example, the protein of Group VI may not only be used in the method of Group VII, but may also be used to isolate an antibody. The methods of Groups II, IV-V, VII-VIII may be practiced using various therapeutic agents and do not necessarily have to be used with the products of Groups I, III, VI. As indicated by the claims, materially different products, such as proteins or cDNA, may be used in the method of screening for molecules.

4. The inventions of Groups I, III, VI are structurally and functionally different, are drawn to structurally and functionally different molecules, each invention requires different reagents and steps to make and characterize them, or different methods of use that do not share common steps or reagents and rely on different endpoints.

5. The inventions of Groups II, IV-V, VII-VIII relate to methods but each method differs in method steps, modes of operation, reagents needed and serve different endpoints and effects.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, divergent subject matter, and require different search strategies, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie Davis, Ph.D.
June 13, 2001


BRENDA BRUMBACK
PATENT EXAMINER